

REMARKS/ARGUMENTS

This Amendment is in response to the Final Office Action mailed July 10, 2003. In the Final Office Action, the Examiner rejected claims 1-9, 11-13, and 51-52 under 35 U.S.C. §102(b); and claims 1-2 and 10 under 35 U.S.C. §103(a). Applicant has canceled claims 53-74, and added claims 75-82. Applicant submits that the newly-added claims introduce no new matter. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Claims 1-20, 51 and 52 were previously presented. Claims 53-74 are canceled and new claims 75-82 are added. As a result, Claims 1-20, 51, 52 and 75-82 remain pending in the application.

Rejection Under 35 U.S.C. § 102

Rejection of Claims 1-9, 11-13 and 51-52 under 35 U.S.C. 102(b) and Rejection of Claims 1-2, 10 and 14-20 under 35 U.S.C. 103(a)

The above Claims are directed to a method that employs a biosensor having a plurality of electrodes that are each “consisting of a single layer of an electrically conductive material.”

The Examiner rejects each of Applicant’s arguments on the grounds that “Cozzette et al. do teach a biosensor having a plurality of electrodes and that each electrode consist ‘of a single layer of an electrically conductive material.’” See Office Action mailed July 10, 2003.

Independent Claim 1 includes the phrase “consisting of” in the body of the claim. The use of this phrase in the body of a claim is addressed in MPEP 2111.03, ¶3. The same paragraph states that the phrase “‘consisting of’ excludes any ... ingredient not specified in the claim.” As a result, the Claim 1 language “electrodes consisting of a single layer of an electrically conductive material” excludes multi-layer electrodes.

In supporting the above rejections, the Examiner states that “(t)he reference electrode is a silver electrode that comprises a ‘combination’ of silver and silver chloride ... shown as reference numerals 4 and 4’ in Figure 2.” The reference numeral 4 and 4’ each denote a different layer of material on the electrode. Specifically, “silver and silver chloride are designated by 4 and 4’, respectively, in the reference electrode structure.” See Col. 24, lines 53-55. Hence, 4

denotes silver and 4' denotes silver chloride. As a result, the text cited by the Examiner specifically teaches a multi-layer electrode.

Further, the Cozzette biosensor requires multi-layer electrodes. Cozzette's biosensors are operated by measuring the difference between the potential at an indicator electrode and the potential at a reference electrode. See column 22, line 52-54; column 23, line 5-8; column 23, line 32-35; column 29, lines 41-42; column 54, lines 48-49; etc. The potential at the reference electrode results from the interaction of the different layers in the reference electrode. If the reference electrode were constructed of a single layer of material, there would not be a potential at the reference electrode. Without the potential at the reference electrode, there is no potential against which to measure the potential at the indicator electrode. As a result, the potential of the indicator electrode is free to "float" and the potential measurements will not provide meaningful results. For instance, see column 23, lines 5-8. Accordingly, the Cozzette biosensors rely on a multi-layer electrode construction to achieve meaningful results.

Because Cozzette teaches biosensors with multi-layer electrodes and relies on multi-layer electrodes to achieve successful operation, Cozzette does not teach biosensors where each electrode consists of a single layer of an electrically conductive material in contrast to the Examiner's Argument. Because this argument is the foundation for the Examiner's response to Applicant's arguments under both 35 U.S.C. 102(b) and 35 U.S.C. 103(a), these rejections should be withdrawn.

Rejection Under 35 U.S.C. § 103

The Examiner rejects Claims 1-2 and 10 as unpatentable over Cozzette in view of U.S. Patent 5,403,700 (Heller). The Examiner also rejects Claims 1-2 and 14-20 as unpatentable over Cozzette in view of U.S. Patent 5,200,051 (Han).

Applicant previously argued that there is no "suggestion or motivation ... to modify the references or combine reference teachings" of Han and Cozzette or of Heller and Cozzette. Applicant also argued that there is not "a reasonable expectation of success" when examining Cozzette in view of Heller or when examining Cozzette in view of Han.

The motivation to combine and expectation of success addressed by the applicant are elements of the prima facie case of obviousness required to properly combine references. See

MPEP706.02(j) and MPEP2142, ¶3. The “examiner bears the initial burden of factually supporting any prima facie conclusion of obviousness.” See MPEP2142, ¶3.

The Examiner has not addressed the Applicant’s arguments directed to the motivation to combine and expectation of success. Further, the Examiner has not shown the expectation of success and motivation to combine required to properly combine references under MPEP2142, ¶3 or under 706.02(j). As a result, the cited references are not properly combined and the rejections under 35 U.S.C. 103(a) should be withdrawn.

Conclusion

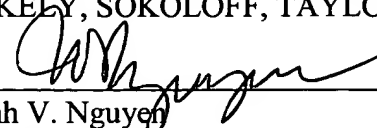
Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

Dated: 11/10/03

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